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REMARKS

This paper is in response to the office action mailed November 27, 2006. Claims 1-43 are under consideration in the application. Claims 1-3, 6-15, 18, 21-25, 28-32, 36-38, and 41-43 have been rejected. Claims 4, 5, 16, 17, 19, 20, 26, 27, 33-35, 39, and 40 have been objected to. No claims are amended by this paper. Reconsideration and further examination of the application is respectfully requested.

The invention relates to a photography system with remote subject designation.

Rejections under 35 U.S.C. § 102

Claims 1, 6-15, 21, 23, 28-32, 36-38, 41, and 43 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Vaarala (U.S. Pat. No 7,134,078). Applicant respectfully traverses.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites in part a photography system comprising

- a) a remote control that casts a light spot on a photographic subject; and
- b) a digital camera having a field of view, which digital camera can detect in its field of view the position of the light spot, and which digital camera selects a region from its field of view to photograph based on the detected position of the light spot.

Vaarala fails to disclose at least the underlined elements of Applicant's claim 1 as shown above, and therefore does not anticipate claim 1. Vaarala discloses a presentation system, in which "detection means", which may include "camera means", locates a "bright laser spot on the projected image." (Vaarala column 4 lines 22-47) However, rather than selecting a region to photograph based on the detected position of the spot, the system of Vaarala uses its spot "to provide at least one control function for the presentation based on information from the detector means". (Vaarala column 2 lines 4-6) Vaarala makes no mention of select[ing] a region ... to photograph. Vaarala's "camera means is adapted to take images of the display". (Vaarala column 5 line 51). Presumably, this means the entire display, so that the laser spot may be tracked over the entire display.

In support of the rejection, the examiner cites column 4 lines 28-31 Vaarala as disclosing a digital camera that selects a region from its field of view to photograph based on the detected position of the light spot. The cited passage does not support the rejection. The cited passage only states that “the camera means can be used to track the location of the spot”, and does not mention select[ing] a region ... to photograph.

Because Vaarala does describe each and every element of Applicant’s claim 1, claim 1 is not anticipated by Vaarala. Claims 6-15 and 21 depend from claim 1 and add further limitations, and are therefore also not anticipated by Vaarala.

Similarly, claim 23 is a method claim that recites in part automatically selecting, based on the position of the light spot, a region from the camera’s field of view to photograph. As is explained above with respect to claim 1, Vaarala does not disclose this element, and therefore does not anticipate claim 23. Claims 28-32, 36-38, and 41 depend from claim 23 and add further limitations, and are therefore also not anticipated by Vaarala.

Claim 43 recites a photography system comprising

- a) means for detecting, in a field of view of a digital camera, the position of a light spot cast on a photographic subject using a remote control;
and
- b) means for digitally framing a photograph based on the detected position of the light spot.

As defined in Applicant’s specification, digital framing is the selection of a subarray from a digital photograph (specification page 6 lines 10-18), and is analogous to the automatic selection of a region to photograph as claimed in claims 1 and 23. As is shown above with respect to claims 1 and 23, Vaarala does not disclose this element, and therefore does not anticipate claim 43.

Rejections under 35 U.S.C. § 103

Claims 2, 3, 18, 22, 24, 25, and 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Vaarala. Applicant respectfully traverses the rejection because the examiner has not made out a prima facie case of obviousness.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (MPEP 2143)

Without conceding either of the first two criteria, Applicant respectfully asserts that the combined references do not teach or suggest all of the limitations of the rejected claims.

Claims 2, 3, 18, 22 depend from claim 1 and add further limitations. Claims 24, 25, and 42 depend from claim 23 and add further limitations. In rejecting these claims, the examiner relies on Vaarala to teach all of the elements of claims 1 and 23. As is shown above, Vaarala in fact does not teach or suggest all of the elements of either claim 1 or 23, and therefore the examiner's prima facie case fails.

Claim Objections

Claims 4, 5, 16, 17, 19, 20, 26, 227, 33-35, 39, and 40 have been objected to for depending on a rejected base claim. In light of the above comments, Applicant believes the base claims from which these claims depend to be allowable. Applicant respectfully requests that the objection be withdrawn.

Other Art

The examiner has made of record but not relied upon Ogawa (U.S. Pat, No, 5,572,251), Kenoyer (U.S. Pat. App. Pub. 2003/0174146), Hiramatsu (U.S. Pat. No 6,798,926), Barrus (U.S. Pat. No. 5,914,783), Iida et al. (U.S. Pat. No. 7,057,643), Kahn et al. (U.S. Pat. App. Pub. 2002/0149681), Matsuoka et al. (U.S. Pat. No. 7,039,253), Kakiuchi et al. (U.S. Pat. No. 6,961,092), and Aboutalib et al. (U.S. Pat. No. 5,867,587). The cited references, even in combination, do not teach or suggest all of the elements of Applicant's claims.

Conclusion

Applicant believes this application is in condition for allowance, and such action is earnestly solicited.

Respectfully submitted,

By David W. Boyd
David W. Boyd
Reg. Number 50,335

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Fort Collins, CO 80528
(970) 898-4475